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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,217	08/07/2003	Michael R. Fender	10030340-1	3330

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
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EXAMINER

TSAI, CAROL S W

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/638,217

Applicant(s)

FENDER, MICHAEL R.

Examiner

Carol S. Tsai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 19-22 is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 14 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent No. 6,703,550 to Chu.

Chu discloses a method for operating a measurement and testing instrument configured to measure a characteristic of a device-under-test, the method comprising the steps of: receiving a first user input provided via a first component of a pointing device (see Figs. 3 and 4 and col. 3, lines 37-55); moving a cursor displayed on a display device responsive to the first user input (see

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col. 2, lines 37-41 and col. 14, lines 30-43); receiving a second user input provided by rotating a second component of the pointing device (see Figs. 3 and 4; col. 8, lines 17-33; and col. 14, lines 43-47); identifying a module that corresponds to a current location of the cursor and providing the second user input to the module (see col. 2, lines 37-41 and col. 8, lines 26-51); and performing by the module an action that is specified by the user input (see Fig. 11; col. 12, lines 23-30; col. 14, lines 33-43; and col. 16, lines 8-25).

As to claim 16, Chu also discloses one of a mouse, a touch-pad, a track-ball and a joystick (see col. 3, lines 45-48).

As to claim 17, Chu also discloses the item is displayed near the cursor when the second user input is received (see col. 14, lines 33-43).

As to claim 18, Chu also discloses specifying one of a display setting and a measurement setting (see col. 8, lines 34-43).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of U.S. Patent No. 5,129,722 to Mader et al.

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As noted above, Chu disclose the claimed invention, except for testing instrument being one of an oscilloscope, a spectrum analyzer, a logic analyzer, a vector analyzer, a network analyzer, and a time interval analyzer.

Mader et al. teach testing instrument being one of an oscilloscope, a spectrum analyzer, a logic analyzer, a vector analyzer, a network analyzer, and a time interval analyzer (see col. 1, lines 13-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chu's method to include testing instrument being one of an oscilloscope, a spectrum analyzer, a logic analyzer, a vector analyzer, a network analyzer, and a time interval analyzer, as taught by Mader et al., in order to measure or control a unit under test or process.

Allowable Subject Matter

6. Claims 1-13 and 19-22 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

U. S. Patent No. 6,703,550 to Chu is the reference closest to the claimed invention. Chu discloses a method for operating a measurement and testing instrument configured to measure a characteristic of a device-under-test, the method comprising the steps of: receiving a first user input provided via a first component of a pointing device; moving a cursor displayed on a display device responsive to the first user input; receiving a second user input provided by rotating a second component of the pointing device; and modifying an item displayed on the display device responsive to the second user input and responsive to where the cursor is located when the

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second user input is received . However, Chu does not teach modifying an item displayed on the display device responsive to the second user input and responsive to where the cursor is located when the second user input is received, the item corresponding to a measurable characteristic of the device-under-test; and including all of the other limitations in the respective independent claims.

Response to Arguments

8. Applicant's arguments filed June 21, 2005 have been fully considered but they are not persuasive.

Applicant argues that Chu does not teach a device-under-test (DUT) from which characteristics of the DUT are monitored or measured. In response to applicant's arguments, the recitation "a device-under-test (DUT) from which characteristics of the DUT are monitored or measured" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness.

Applicant argues that Chu fails to disclose the feature of "identifying a module that corresponds to a current location of the cursor". The Examiner disagrees with Applicant. As set forth above in the art rejection, Chu does teach identifying a module that corresponds to a current location of the cursor (see col. 2, lines 37-41 and col. 8, lines 26-51).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol S. W. Tsai whose telephone number is (571) 272-2224. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571) 272-2216. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).



Carol S. W. Tsai
Primary Examiner
Art Unit 2857

cswt
July 27, 2005